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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,815	04/20/2000	Steven G. Goldstein	50N3483/1333	4648

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/552,815

Applicant(s)

Goldstein et al

Examiner

Mark Wallerson

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 5, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2622

### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on 7/5/2002.
2. This application has been reconsidered. Claims 1-65 are pending.

**Please note that a new Examiner has been assigned to this case.**

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“Economically implemented” is unclear

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 2622

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 3, 5, 6, 7, 8, 9, 10, 12, 13, 14, 18, 19, 20, 21, 22, 24, 26, 28, 29, 30, 35, 36, 37, 41, 42, 43, 44, 45, 47, 48, 49, 50, 51, 55, 56, 58, 59, 60, 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Enomoto et al (Enomoto) (U. S. 5,974,401).

With respect to claims 1, 5, 22, 24, 28, 45, 49, 50, 51 Enomoto discloses a system for transferring image data to a service provider (12), comprising an image source (20 or 21), and an image pump (which reads on computer 11) configured to receive the image data from the image source by a hard-wired connection (column 6, lines 23-32), and provide the image data to the service provider (column 6, lines 44-50), the image pump (11) being implemented separately from the image source (20 or 21).

With regard to claims 3 and 26, Enomoto discloses receiving text data from the image source (column 6, lines 24-30).

With respect to claims 6 and 29, Enomoto discloses storing the image data on a removable storage medium (column 6, lines 24-28).

Art Unit: 2622

With regard to claims 7, 8, 9, 10, 30, 31, 32, and 33 Enomoto discloses communicating with the service provider via a wireless (radio telephone line); hard-wired (cable); ethernet (which reads on a network such as the Internet), or a public switched telephone network (column 3, lines 21-30 and column 4, lines 61-65).

With respect to claims 12 and 35, Enomoto discloses the image pump controls the transfer of data from the image source to the service provider (column 6, lines 24-50).

With regard to claims 13, 36, and 61, Enomoto discloses configuring the image data to conform to a format required by the service provider (column 3, lines 41-60).

With respect to claims 14, 37, and 47, Enomoto discloses the image pump includes customer account information (column 3, line 64 to column 4, line 4).

With regard to claims 18, 19, 41, and 42, Enomoto discloses the image pump has a touchscreen for displaying the image data to the user (column 6, lines 44-50).

With regard to claim 20, 21, 43, and 44, Enomoto discloses determining user selections and transferring the selections to the service provider (column 6, lines 44-50).

With respect to claims 48 and 60, Enomoto discloses capturing image data utilizing an image source (20 or 21); sending the image data to an image pump (11); attaching customer account information to the image data (column 3, line 64 to column 4, line 4); sending the image data and customer account information to the service provider (column 6, lines 44-50); determining if the image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are

Art Unit: 2622

detected (column 7, lines 4-8); providing services by the service provider (column 7, lines 23-40, and returning a final product to the user, along with a bill (column 7, line 41 to column 8, line 12).

With regard to claims 55, 56, Enomoto discloses allowing a user to view and select individual images to be processed (column 6, lines 44-50) and attaching specific instruction to the images (column 6, lines 44-64).

With respect to claims 58 and 59, Enomoto discloses attaching customer information to the data (column 3, line 64 to column 4, line 4).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2622

8. Claims 62 and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Safai (U. S. 6,167,469).

With respect to claim 62 and 64, Safai discloses capturing image data by utilizing an image source (100); providing the image data to an image pump (figure 2) integral with the camera; converting the image data to a format compatible with the service provider (column 5, lines 28-62 and column 7, lines 14-50); attaching user defined instructions and customer account information (column 7, lines 32--50 and column 15, lines 16-27); transferring the image from the image pump to the service provider (column 2, lines 1-3); reviewing the order and providing services to the user (column 15, lines 17-58).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 25, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell et al (Bell) (U. S. 6,147,742).

With respect to claims 2, 25, and 52, Enomoto differs from claims 2, 25, and 52 in that although he discloses the image source is a camera, he does not clearly disclose receiving audio data from the image source. Bell discloses a photofinishing system wherein audio data is coupled

Art Unit: 2622

with the text/image data prior to being sent to the photofinisher (column 3, line 60 to column 4, line 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto wherein audio data is received from the image source. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to allow for a variety of output media and formats as disclosed by Bell in column 2, lines 25-29.

11. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Cok (U. S. 6,157,436).

With respect to claims 4 and 27, Enomoto differs from claims 4 and 27 in that he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means (column 7, lines 35-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Cok in order to obtain data from different sources.

12. Claims 15, 16, 17, 38, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell.

With respect to claims 15, 16, 17, 38, 39, and 40, Enomoto differs from claims 15, 16, 17, 38, 39, and 40 in that he does not clearly disclose the image source includes a pump manager to



Art Unit: 2622

control the transfer of data from the source to the service provider. Bell discloses the image source (30) includes a pump manager (order manager) to control the transfer of data from the source to the service provider (column 3, line 60 to column 4, line 24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to improve the image processing.

13. Claims 23 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Safai (U. S. 6,167,469).

With respect to claims 23 and 46, Enomoto differs from claims 23 and 46 in that he does not clearly disclose the image pump is implemented in the digital camera. Safai discloses that the image pump (figure 2) is provided in the digital camera (column 5, line 55 to column 6, line 18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto wherein the image pump is implemented in the digital camera. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Safai in order to have a more compact system.

14. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Cok.

With respect to claims 11 and 34, Enomoto differs from claims 11 and 34 in that he does not clearly disclose the image pump stores the image data on removable medium that may be transported to the service provider. Cok discloses storing the image data on a removable medium

Art Unit: 2622

(112) prior to transporting them to a photofinisher (160). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Cok in order to improve user efficiency.

15. Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell.

With respect to claim 53, Enomoto differs from claim 53 in that he does not clearly disclose source transfer means external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider. Bell discloses source transfer means (the order manager) external to the image source and image pump allows the image source to download data to the image pump and allows the image pump to upload data to the service provider (column 4, line 42 to column 5, line 60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

With respect to claim 57, Enomoto differs from claim 57 in that he does not clearly disclose that the image pump does not have a video display and a user signals the image pump to transfer data. Bell discloses an image pump (34) that does not have a video display and a user signals the image pump to transfer data (column 5, lines 1-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Bell in order to simplify the system.

Art Unit: 2622

16. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Bell as applied to claim 53 above, and further in view of Cok.

With respect to claim 54, Enomoto as modified differs from claim 54 in that although he discloses transferring the data to the service provider in a cable or wireless manner (column 4, lines 61-65), he does not clearly disclose the image source communicates with the image pump by wireless means. Cok discloses a photofinishing system wherein an image pump (170) receives data from an image source via wireless (optical) means or disk (112) and transfers the data to the photofinisher (160) by wireless, disk or cable means (column 7, lines 4-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Enomoto by the teaching of Cok in order to obtain data from different sources.

17. Claims 63 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai in view of Enomoto.

With respect to claim 63, Safai differs from claim 63 in that he does not clearly disclose that the image source is a scanner. Enomoto discloses a scanner as an image source (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to vary the image sources.

With respect to claim 65, Safai discloses including customer account information (column 15, lines 17-27). Safai differs from claim 65 in that he does not disclose determining if the image data and customer information have errors, and requesting the image pump to re-transmit the image data and customer information if errors are detected. Enomoto discloses determining if the

Art Unit: 2622

image data and customer information have errors (column 7, lines 4-8), and requesting the image pump to re-transmit the image data and customer information if errors are detected (column 7, lines 4-8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Safai by the teaching of Enomoto in order to improve the image system.

*Response to Arguments*

18. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

Art Unit: 2622

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

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MARK WALLERSON  
PRIMARY EXAMINER

MARK WALLERSON